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JGJR: 11-03

Paper No: 23

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OFFICE OF PETITIONS

In re Application of
Short

Application No. 09/089,789

Filed: 3 June, 1998

Attorney Docket No. DIVER1270-3

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ON PETITION

This is a decision on the petition filed herein on 25 September, 2003, under 37 C.F.R. §1.137(a) to revive the above-identified application, and in light of the allegations (alleged non-receipt) considered as a petition to withdraw the holding of abandonment under 37 C.F.R. §1.181.

For the reasons set forth below, the petition:

- the petition as considered under 37 C.F.R. §1.181 to withdraw the holding of abandonment is **GRANTED** and fees are waived; and
- under 37 C.F.R. §1.137(a) is **DISMISSED as moot**.

BACKGROUND

The record indicates that:

- it appeared that Petitioner failed to reply timely and properly to the final Office action mailed on 9 May, 2002, with the reply due (absent a request and fee for extension of time) on or before Friday, 9 August, 2002;
- the application was deemed abandoned after midnight 9 August, 2002;

- Notice of Abandonment was mailed on 2 February, 2003;
- Petitioner's first petition under 37 C.F.R. §1.181 was dismissed in the Group without prejudice for failure to file within two months of the action complained of (Notice of Abandonment) 37(b);
- the instant petition under 37 C.F.R. §1.137(a) evidences, *inter alia*: Petitioner's attempt to contact the Examiner beginning at least on 25 February, 2003; Petitioner's docket records evidencing non-receipt of the Office action; and the Technology Center indicates that a copy of the Office action is not available--which would preclude Petitioner from providing the reply that is a requirement of the regulation;
- the Technology Center has requested that the holding of abandonment be withdrawn and the file returned to the Examiner for his reconsideration of the Amendment filed on 15 August, 2001.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).¹

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.²

Delays in responding properly raise the question whether delays are unavoidable.³ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing

¹ 35 U.S.C. §133 provides:
35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

² Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

³ See: *Changes to Patent Practice and Procedure, Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁴ And the Petitioner must be diligent in attending to the matter.⁵ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁶))

Allegations as to the Request to Withdraw
the Holding of Abandonment and
the Petition Alleging Unintentional Delay

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.⁷

Petitioner contends and evidences non-receipt of the 9 May, 2002, final Office action, and the Technology Center requests withdrawal of the holding of abandonment and return of the file to the Technology Center. The requirements for withdrawing the holding of abandonment are satisfied.

CONCLUSION

Accordingly:

- Petitioner satisfied the burdens set forth in Delgar v. Schulyer, and the petition under 37 C.F.R. §1.181 hereby is **granted** and the 3 February, 2003, Notice of Abandonment is **vacated** and fees in connection with this petition are waived; and
- the petition under 37 C.F.R. §1.137(a) is **dismissed as moot** and the fee in connection with this petition are refunded to Petitioner via Treasury Check.

The instant application is forwarded to Technology Center 1600 for further processing.

⁴ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁵ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

⁶ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

⁷ See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.

A handwritten signature in black ink, appearing to read "J. Gillon, Jr.", with a stylized flourish at the end.

John J. Gillon, Jr.
Senior Attorney
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